## REMARKS

### I. Summary of the Office Action

Claims 14-16 and 40-68 are pending in this application.

The Examiner rejects claims 14-16, 40-51, 53-56, 58-61, 63-66, and 68 under 35 U.S.C. § 102(b) as being anticipated by Hite et al. U.S. Patent No. 5,774,170 (hereinafter "Hite").

Claims 52, 57, 62, and 67 are rejected under 35 U.S.C. § 103(a) as being obvious from Hite in view of Welsh U.S. Patent No. 4,857,999 (hereinafter "Welsh").

### II. Summary of Applicant's Reply

Applicant has amended claims 14-16, 40, 41, and 43-46 to more particularly define the invention. No new matter has been introduced as a result of these amendments.

The Examiner's rejections are respectfully traversed.

### III. Applicant's Reply to the § 102 Rejection

Claims 14-16, 40-51, 53-56, 58-61, 63-66, and 68 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hite. This rejection is respectfully traversed.

A. Claims 14-16 and 40-48

Applicant's invention, as defined by independent claims 14, 40, 43, and 46, is directed towards presenting a forced advertisement on user equipment, and continuing to present the forced advertisement after the television viewer turns off and on the user equipment.

Hite discusses delivering targeted advertisements to consumers through television programming.

The Examiner's contends that the feature of "continuing to present the forced advertisement after the television viewer turns on and off user equipment on which the forced advertisement was being presented," as required by independent claims 14, 40, 43, and 46, is inherent to Hite and broadcast television systems in general (see Office Action, page 3, lines 3-5). The Examiner observes that a television viewer may turn user equipment off after a commercial has begun and turn user equipment on before the commercial ends, which could be construed as continuing to present the forced advertisement (see Office Action, page 3, lines 5-9).

In view of the Examiner's observation, applicant has amended independent claims 14, 40, 43, and 46 to require that when the user equipment is turned back on, the forced

advertisement is presented from the beginning of the forced advertisement or the forced advertisement recommences from the point at which the user equipment was turned off. Applicant submits that this feature is not shown or suggested by Hite nor is it inherent to Hite or broadcast television systems in general. For at least this reason, amended independent claims 14, 40, 43, and 46 and dependent claims 15, 16, 41, 42, 44, and 45 are allowable. Therefore, this rejection should be withdrawn.

B. Claims 49-51, 53-56, 58-61, 63-66, and 68

Applicant's invention, as defined by independent claims 49, 54, 59, and 64, is directed towards displaying a forced advertisement on a display. The forced advertisement is selected to replace a broadcast advertisement, in which the broadcast advertisement is associated with a first advertiser that is a competitor of the advertiser associated with the forced advertisement.

Hite discusses delivering targeted advertisements to consumers through television programming. Targeted advertisements may preempt regularly broadcast commercials that are identified as conditionally or unconditionally preemptable. Hite provides an example of a conditionally-

preemptable commercial that may only be preempted by commercials for non-competing products.

Applicant respectfully submits that Hite fails to show or suggest selecting a forced advertisement associated with a second advertiser to replace a broadcast advertisement associated with a first advertiser, wherein the second advertiser is a competitor of the first advertiser, as required by independent claims 49, 54, 59, and 64. The Examiner contends that "Hite offers an example of NOT using a competitor's commercial to preempt another ... this logic could easily be reversed, and we could arrive at the idea or replacing a competitor's commercial with the broadcast commercial (emphasis in original)(Office Action, page 6, lines 2-4).

Contrary to the Examiner's contention, applicant submits that even though Hite shows the opposite of applicant's claimed feature, this showing is not sufficient to establish anticipation of independent claims 49, 54, 59, and 64 by Hite. In order for Hite to anticipate independent claims 49, 54, 59, and 64, Hite must show <u>each and every feature</u> of independent claims 49, 54, 59, and 64. The Examiner cannot use logic to arrive at applicant's claimed invention. In fact, Hite's example of not using a

competitor's commercial to preempt another teaches away from applicant's claimed feature of replacing a competitor's advertisement with a forced advertisement. Accordingly, for at least the reasons that Hite fails to show or suggest each of applicant's claimed features and that Hite teaches away from applicant's invention, independent claims 49, 54, 59, and 64 and dependent claims 50, 51, 53, 55, 56, 58, 60, 61, 63, 65, 66, and 68 are allowable. This rejection should therefore be withdrawn.

IV. Applicant's Reply to the § 103 Rejection

Claims 52, 57, 62, and 67 are rejected under 35 U.S.C. 103(a) as being obvious from Hite in view of Welsh. Independent claims 49, 54, 59, and 64 have been shown above to be allowable. Accordingly, dependent claims 52, 57, 62, and 67 are also allowable because they depend from independent claims 49, 54, 59, and 53. Therefore, this rejection should be withdrawn.

V. Conclusion

In view of the foregoing, claims 14-16 and 40-68 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

Hong S. Lin
Registration No. 54,629
Agent for Applicant
Fish & Neave IP Group
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090